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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/817,602	04/02/2004	Thomas B. Lee	29106.00	3141
22465	7590	01/24/2006		
PITTS AND BRITTIAN P C P O BOX 51295 KNOXVILLE, TN 37950-1295			EXAMINER SMITH, KIMBERLY S	
			ART UNIT 3644	PAPER NUMBER
DATE MAILED: 01/24/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/817,602

Applicant(s)

LEE ET AL.

Examiner

Kimberly S. Smith

Art Unit

3644

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --****Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 November 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) 1-13 and 18-28 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 14-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election with traverse of Group II in the reply filed on 11/07/05 is acknowledged. The traversal is on the ground(s) that the timing of the restriction requirement is improper. This is not found persuasive because as the Applicant has pointed out in section 811 of the MPEP, a restriction may be made at any time before final action. As the case is not currently under a final action, the timing of the restriction requirement is proper. The Applicant has further stated the Examiner has not established the restriction is proper as reasons for distinctness were not provided nor providing a reason for serious burden on the examiner. The distinctness of invention was discussed in paragraphs 2-4 of the requirement and the burden on the examiner was discussed in Paragraph 5 of the requirement. With respect to the arguments pertaining to Groups I and II, the Applicant has not detailed what is specifically wrong with the Examiner's reasoning for distinctness and therefore the general arguments are not found persuasive. With respect to the argument relating to Groups I and III in that the apparatus is not capable of producing a continuous signal resulting in a stimulation without verification. The apparatus as claimed is capable of sending a coded signal to the stimulation device, and after the verification of the coded signal, that signal is capable of being maintained for a continual generation of the stimulus. Therefore the apparatus is capable of functioning in a method other than claimed thereby making restriction between groups I and III proper.

2. With respect to Group II, the Applicant has stated that this group is directed to a single product claim. For the purpose of the restriction requirement and the reasoning thereof, claims 14-17 were construed to be directed to a process. This assumption was based upon the vague nature of the claim structure including the use of "The process" in the preamble of claims 15 and

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16 and the lack of any corresponding product structure in the claims. The requirement is still deemed proper and is therefore made FINAL.

3. Claims 1-13 and 17-28 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 11/07/05.

#### ***Response to Arguments***

4. Applicant's arguments filed 06/01/05 have been fully considered. With respect to the arguments relating to claims 1-13 and 18-28, the arguments have been considered however, as claims 1-13 and 18-28 have been withdrawn from consideration, the arguments are deemed moot with respect to the current invention under prosecution. With respect to the arguments regarding claims 14-16. The Applicant has stated that the Duncan (US 6,170,439) reference does not disclose the processor producing a signal that varies the voltage to produce the desired stimulation level. This is respectfully disagreed with. As can be seen in the Abstract of the patent, Duncan discloses a signal that "causes the amplitude of voltage pulses produced...to be representative of the selected stimulus level". As such, it is maintained that the variation in amplitude of voltage pulses as disclosed by Duncan to control the selected stimulus level anticipate the limitation regarding a signal that varies the voltage to produced the desired stimulation level. The rejection is maintained.

#### ***Claim Rejections - 35 USC § 101***

5. 35 U.S.C. 101 reads as follows:

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Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 14-17 are rejected under 35 U.S.C. 101 because the claimed invention lacks patentable utility. Claims 14-17 are lacking any structural limitation regarding an apparatus. The preamble of claim 14 appears to be directed to a product claim (as discussed by the Applicant in the response to the restriction requirement) however, the body of the claim is directed to process steps which provide no defining limitations to a product claim. Further, claims 15-16 include a preamble directed to a process claim depending from what appears to be an apparatus claim which thereby also do not provide any structural limitation for which the applicant can seek a patent. As there is a lack of any structure, the invention lacks patentable utility.

Claims 14-17 are also rejected under 35 U.S.C. 112, first paragraph. Specifically, since the claimed invention is not supported by either a specific asserted utility or a well established utility for the reasons set forth above, one skilled in the art clearly would not know how to use the claimed invention.

### ***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 14-17 *as best understood* are rejected under 35 U.S.C. 102(b) as being anticipated by Duncan et al., US Patent 6,170,439 (Duncan).

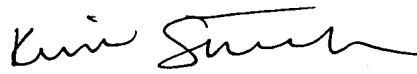
Duncan discloses an apparatus for training an animal with an audible and electrical stimulation inclusive of a transmitter and a receiver whereby a signal is variable to produce a variable stimulus. Reference discussions in prior office action and above in paragraph 4.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kimberly S. Smith whose telephone number is 571-272-6909. The examiner can normally be reached on Monday thru Friday 10:00-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Teri Luu can be reached on 571-272-7045. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Kimberly S Smith  
Examiner  
Art Unit 3644

kss